

71. (New) A communications device as defined in claim 39 wherein the communications device comprises a PCMCIA Type III compliant communications card.

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REMARKS

As an initial matter, Applicant would like to thank the Examiner for the help previously provided in other related applications commonly owned with the present application and for the attention given to the present application. The help provided at the personal interview conducted with the Examiner on July 28, 2000 is especially appreciated. At that interview, the Examiner and Applicant's representative discussed making a claim to priority to an earlier application and how the claim to priority removed all of the prior art references required to sustain the Section 103 rejections raised in the last Office Action. The subject matter set forth in the independent claims was discussed in view of the remaining prior art reference. At the interview, the Xircom™ RealPort™ Ethernet 10/100 RE-100 integrated PC card was examined. The Examiner's observations and suggestions provided during the interview are appreciated, and the Examiner's guidance provided during the interview has been incorporated herein by this paper.

Each of the objections and rejections raised in the Office Action mailed March 20, 2000 either have been addressed above or will be addressed below.

Entry of this Amendment is appropriate because entry will result in allowance of all of the remaining claims. The amendments to the claims merely make formal changes and make changes to address the objections raised in the last Office Action. Moreover, the claim to priority to earlier applications which has now been made has mooted the prior art rejections which were raised in the last Office Action.

REJECTIONS UNDER 35 U.S.C. § 112

The remaining independent claims 34 and 39 have been amended to alleviate the section 112, first paragraph rejection.

Claims 34 - 43 were rejected in the Office Action on the grounds that they contained subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Applicant respectfully traverses this rejection, and submits that the claims, as amended, are fully supported by the specification. The recitation of "8mm" in claims 34 and 39 has been deleted to remove the basis of any such rejection, although Applicant believes there is adequate support for this recitation in the specification. Instead, as discussed at the interview,

the claims now contain the recitation of the "PCMCIA standards" for a Type III card to provide suitable subject matter for presentation in the claims. The recitation of "PCMCIA standards" is fully supported in Applicant's specification, for example, at page 18, line 20 through page 19, line 1; at page 53, line 20 through page 54, line 1; at page 55, lines 19-21; at page 61, lines 10-12; at page 63, lines 17-18; and at page 68, line 19 through page 69, line 1.

Claim 34 is supported by disclosure throughout the specification, and the terminology used therein is likewise taken from the specification.

Independent claim 34 contains subject matter that is disclosed several times at several different places throughout Applicant's specification. Embodiments of the present invention which feature the subject matter of claim 34 are disclosed in at least FIGS. 6-9, 14, 22, 23, 25 and 29, among others, and the corresponding written descriptions. At page 28, line 19 to page 29, line 8, FIG. 6 is discussed. As Applicant's specification, and particularly Applicant's drawings, show, this embodiment features a removable receptacle 151 that is easily removed from the card 150. As shown in FIG. 6, the removable receptacle 151 functions as one example of the connector housing means, and the card 150 functions as one example of the body means. Structures which are one preferred arrangement for performing the function of the means for removably attaching the connector means to the

body means are disclosed in FIG. 6, as the wings 158, which may be manipulated to allow the receptacle 151 to be removed from the card 150. Exemplary structures which perform the function of the means for conveying a communications signal between the communications line and the signal utilizing device are shown as the contacts 156 and 174 that allow the signal to move between the communications line and the signal utilizing device.

The discussion of FIG. 22 provided in the Detailed Description of the Preferred Embodiments portion of Applicant's specification not only discloses the features set forth in the claim, but also supports the terminology used in the claim. As Applicant's specification shows, this embodiment preferably complies with PCMCIA standards for a Type III card (page 55, lines 19-21), and features a connector housing 351A that may be removably connected to the card body 351B. The connector housing 351A is one example of a structure which functions as the connector housing means, and the card body 351B exemplary functions as the body means. The structures which preferably carry out the function of the means for removably attaching the connector housing means to the body means are disclosed in the embodiment of FIG. 22 and are specifically discussed in Applicant's specification at page 57, line 13 to page 58, line 8, as the female portion 353B that receives the male portion 353A, the connector receptacle 354A that receives the connector plug

354A, and the spring fingers 356B that are received by the recess 356A. An example of the structures which carry out the means for conveying a communications signal between the communications line and the signal utilizing device are represented at the connector plug 354B and connector housing 354A and the conductors 368 that allow the signal to move between the communications line and the signal utilizing device.

The discussion which accompanies FIG. 14 (Applicant's specification at page 36, line 5 to page 37, line 13), FIG. 23 (page 60, lines 1-2), FIG. 25 (page 63, line 16) and FIG. 29 (page 68, line 19 to Page 69, line 1) provides further support for the structure recited in claim 34 and the terminology used therein. Applicant respectfully submits that the subject matter of claim 34 is fully disclosed in the specification, and that this rejection should accordingly be withdrawn and the claim allowed. Claims 35 to 38 are either directly or ultimately dependent from claim 34 and likewise should be allowed.

Claim 39 is supported by disclosure throughout the specification, and the terminology used therein is likewise taken from the specification.

Similar to claim 34, independent claim 39 contains subject matter that is fully disclosed at several places throughout Applicant's specification. Embodiments of the present invention which disclose the subject matter recited in claim 39 are represented in at least FIGS. 6-9, 14, 22, 23, 25 and 29, among

others, and the corresponding portions of Applicant's specification. For example, at Applicant's specification page 28, line 19 to page 29, line 8 FIG. 6 is discussed. As Applicant's specification shows, the embodiment of FIG. 6 features a removable receptacle 151 that is easily removed from the card 150. The removable receptacle 151 functions as one preferred example of the connector housing of claim 39, and the card 150 functions as one preferred example of the card body of claim 39. FIG. 6 also discloses preferred structures for carrying out the function of the means for removably attaching the connector housing to the card body, specifically the wings 158, which may be squeezed to allow the receptacle 151 to be removed from the card 150. Preferred structures for carrying out the function of the means for conveying a communications signal between the communications line and the signal utilizing device are shown as the connectors 156 and 174 which allow the signal to move between the communications line and the signal utilizing device.

The discussion provided in Applicant's specification which accompanies FIG. 22 not only discloses the features of independent claim 39, but also provides explicit support for much of the claim terminology. As Applicant's specification explains, the embodiment of FIG. 22 preferably complies with PCMCIA standards for a Type III card (page 55, lines 19-21), and

features a connector housing 351A that may be removably connected to the card body 351B. The connector housing 351A is one preferred structure which functions as the connector housing of claim 39, and the card body 351B is one preferred structure which functions as the card body of claim 39. Structures which perform the function of the claimed means for removably attaching the connector housing to the card body are discussed in Applicant's specification, at page 57, line 13 to page 58, line 8, as the female portion 353B that receives the male portion 353A, the connector receptacle 354A that receives the connector plug 354A, and the spring fingers 356B that are received by the recess 356A. Structures which carry out the function of the recited means for conveying a communications signal between the communications line and the signal utilizing device are represented at the connector plug 354B and connector housing 354A and the connectors 366 which allow the signal to move between the communications line and the signal utilizing device.

The discussion in Applicant's specification which accompanies FIG. 14 (page 36, line 5 to page 37, line 13), FIG. 23 (page 60, lines 1-2), FIG. 25 (page 63, line 16) and FIG. 29 (page 68, line 19 to Page 69, line 1) and the embodiments disclosed therein, provides further support for the structures set forth in claim 39 and the terminology used therein. Applicant respectfully submits that the subject matter of claim

39 is fully disclosed in the specification, and that the rejection of this claim under Section 112 should accordingly be withdrawn and the claim allowed. New claims 68 to 71 are either directly or ultimately dependent from claim 39 and likewise should be allowed.

The remaining claims which were rejected under § 112 have been canceled, rendering any § 112 rejections to those claims moot.

Claims 40, 41, 43, 45-51, 53 and 54 were rejected in the Office Action for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Changes to the corresponding figures were required in the Office Action. These claims have been canceled, making these rejections moot. Substitute figures are accordingly not presented.

REJECTIONS UNDER 35 U.S.C. § 102 (B) AND 35 U.S.C. § 103 (A)

The claim to priority to the application filed in 1993, and the cancellation of claims, has overcome the prior art rejections to all claims remaining in this application.

In the last Office Action, the pending claims were rejected as anticipated by or obvious over prior art. All of the rejections based upon prior art are overcome by this paper because of cancellation of the pertinent claim or because of the effective filing date provided by earlier related applications which provides all of the still pending claims with an effective filing date which predates all of the dates of the prior art now



of record which are necessary to sustain the prior art rejections set forth in the last Office Action, as discussed below.

The prior art rejections of independent claims will be the primary subject of the following remarks, with the rejections of the dependent claims being discussed as needed, since the allowance of the independent claims will also provide that the claims depending therefrom are also free from prior art rejections.

In the last Office Action, claims 45-67 were rejected as obvious over Beckham, taken alone or in view of Okada. By this amendment, Applicant has canceled these claims, making this rejection moot.

Claims 45-59 and 64-67 were rejected as anticipated by or obvious over Mitani. By this amendment, Applicant has canceled these claims, making this rejection moot.

Claims 34-45 and 59-63 were rejected as unpatentable as anticipated by, or obvious over McDaniels. Claims 40-63 have been canceled rendering this rejection moot as to them. Claims 34 and 39 and the claims dependent therefrom will be discussed below.

Claims 44-67 were rejected on the grounds of double patenting. These claims have been canceled, rendering the rejection moot.

Independent claims 34 and 39 are allowable over the remaining prior art in view of the reasons set forth in the last Office Action.

Claims 34-43 were rejected in the Office Action as obvious over Aldous in view of Gargiulo, Kakinoki, and Mitani. By this amendment, Applicant has claimed priority to U.S. Patent Application No. 08/151,249 filed on November 12, 1993 (now U.S. Patent No. 5,411,405). This claim to priority results in an effective filing date of November 12, 1993 for the subject matter of all of the pending claims which predates the Gargiulo, Kakinoki, and Mitani references. The Gargiulo reference has a U.S. filing date of September 30, 1996, the Kakinoki reference has a U.S. filing date of November 12, 1993, and the Mitani reference has a U.S. filing date of December 27, 1995. Thus, the effective filing date of all of the pending claims is earlier than the date any of these three references is available for use as prior art against the present claims.

35 U.S.C. 102(e) states that an inventor is entitled to a patent unless:

the invention was described in an application for patent by another filed in the United States before the invention thereof by the applicant...

Since none of the secondary references (Gargiulo, Kakinoki, and Mitani references) is dated before the effective filing date of the application, all of these references have been removed by Applicant's claim to priority to an earlier application filed

November 12, 1993. Applicant respectfully submits that this rejection should accordingly be withdrawn and the claims allowed to issue.

Claims 34-45 and 59-63 were rejected as unpatentable as anticipated by, or obvious over McDaniels. As discussed above, claims 40-63 have been canceled rendering this rejection moot as to them. Independent claims 34 and 39 have been amended to remove the 8mm recitation. The McDaniels reference matured from the '249 application, to which priority has now been claimed, this rejection is thus made moot. Applicant respectfully submits that this rejection should be withdrawn and the remaining claims allowed to issue.

Regarding the one remaining reference, the Aldous reference, as made clear in the last Office Action, the Aldous reference alone, without the Gargiulo, Kakinoki, and Mitani references, does not make the invention set forth in the now pending claims obvious under Section 103. It would be well to briefly review the appropriate standard for determining patentability under Section 103. Under Section 103, it is necessary to determine whether a *prima facie* case of obviousness is present.

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one

of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.

In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988) (citations omitted).

Moreover, a *prima facie* case of obviousness is not established when combining references unless the relied upon references contain some "teaching suggestion" or "incentive" supporting the combination. In re Geiger, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987) ("Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.") citing ACS Hospital Systems, Inc. v. Montefiore Hospital, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

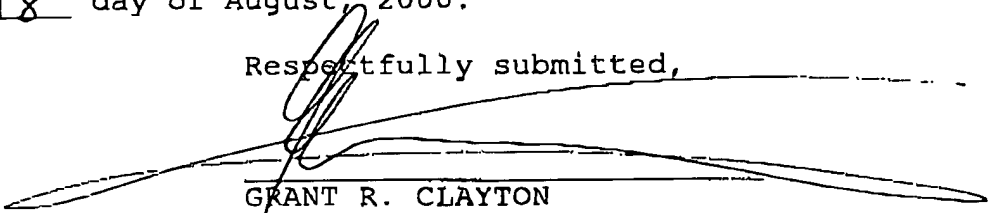
In establishing a *prima facie* case of obviousness, it is improper to "use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." Id. at 1600. Rather, "[t]he test is whether the claimed invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made." Connell v. Sears, Roebuck & Co., 220 U.S.P.Q. 193, 199 (Fed. Cir. 1983).

In view of the forgoing, it is respectfully submitted that all of the remaining claims now present allowable subject matter. Thus, favorable action concerning these claims is respectfully

requested. If any impediment to the allowance of these claims remains after entry of this Amendment and consideration of these remarks the Examiner is invited to initiate a telephone interview with the undersigned.

DATED this 18 day of August, 2000.

Respectfully submitted,



GRANT R. CLAYTON  
Attorney for Applicant  
Registration No. 32,462

CLAYTON, HOWARTH & CANNON, P.C.  
P.O. Box 1909  
Sandy, Utah 84091

Telephone (801) 255-5335  
Facsimile (801) 256-2043

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